

REMARKS

Claims 52-59 are being added. Claims 44-51 are being cancelled without prejudice to filing in a later application and only to reduce claims fees. Claim 39 is being amended. Upon entry of this amendment claims 1, 6, 9, 12, 21, 23, 38-43 and 52-59 will be pending in the application. The amendment and new claims add no new matter.

The amendment to claim 39 is supported by, for example, claim 43.

New claims 52-53 are supported by, for example, paragraph 0036.

New claim 54 is supported by, for example, paragraph 0034 and Table 3.

New claim 55 is supported by, for example, paragraph 0044.

New claims 56-59 are supported by, for example, Table 1 and paragraphs 0022 to 0036.

1) Applicants' response to the rejection of claims 1, 6, 9, 12, 38, 40 and 41-43 under 35 U.S.C. §102(b).

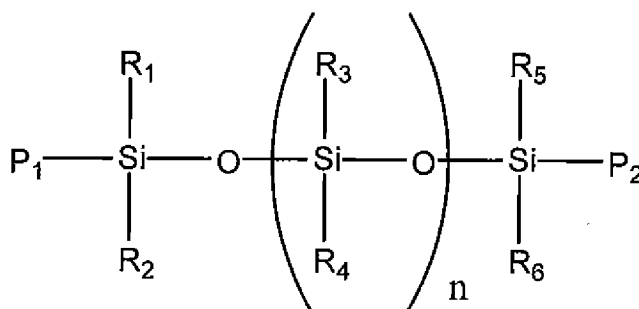
Claims 1, 6, 9, 12, 38, 40 and 41-43 were rejected under 35 U.S.C. §102(b) as allegedly having every feature and interrelationship anticipated by International Publication No. WO 01/40417 to Giraud et al¹, for the reasons given in point 4 of the action. Applicants traverse this rejection.

a) The rejection is improper as Giraud does not teach or suggest all of the features of Applicants' claimed composition.

Claim 1 recites:

A mold release composition having a pH of 7 to 11 comprising a functional siloxane, having the following structure:

¹ All references to Giraud in this Response refer to U.S. Patent No. 6,825,153 which is indicated by the Office to be equivalent to the WO 01/40417 document.



where R_1 , R_2 , R_3 , R_4 , R_5 and R_6 individually can be the same or different, each being selected from the group consisting of C_{1-3} alkyl, vinyl, hydride, and alkoxy groups, where n is about 0 to about 100,000, and where P_1 and P_2 can be the same or different, each being selected from the group consisting of silanol, hydride, hydroxyl, alkyl, vinyl, carbinol and carboxy groups;

a crosslinker, a thickening agent, a base, and water.

Claim 6 recites:

A mold release composition according to claim 1, wherein the crosslinker has the general formula X-SiABC where X is selected from the group consisting of methyl, vinyl, alkoxy, acetoxy, hydride and ethyl groups, and A , B and C are each individually an alkoxy group.

i) Giraud does not disclose a "base".

Giraud recites a composition comprising (a) a nonreactive polyorganosiloxane oil; (b) a polyorganosiloxane resin; (c) a cross-linking agent; (d) a condensation catalyst; (e) a surfactant; and (f) water. Giraud does not teach or suggest use of any base in addition to components (a) - (f). A computer search of Giraud does not find that the word "base" or "organic amine" is used in that document. In sum, there is no teaching or suggestion in Giraud to use a base in that composition.

The action asserts that components (b) and (c) may possibly contain amine moieties which must make them a base. Components (a) and (b) are complicated polyorganosiloxane molecules having only a possible, minor nitrogen atom containing substituent. There is no basis to support this assertion and logically such minor nitrogen atom containing substituents would not be expected to dissociate strongly enough from the complicated polyorganosiloxane molecule to act as a base. To rely on

the theory of inherency in rejecting a claim under 35 U.S.C. 102 or 103, "... the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art." (emphasis in original)². Applicants respectfully request that the Examiner withdraw this rejection or provide evidence showing that components (b) and (c) necessarily act as a base. Claims 1, 6, 9, 12, 38, 40 and 41-43 are patentable for at least this reason.

ii) Giraud does not disclose a "pH".

The only recitation of pH is column 16, TABLE 2 referring to pH of a Styrene-acrylic latex material. Giraud does not disclose a pH for the composition nor is there any reason that the Giraud composition must necessarily have a pH of 7 to 11. Claims 1, 6, 9, 12, 38, 40 and 41-43 are patentable for at least this reason.

b) The rejection is improper as it lacks identification of a lead compound and explanation of how and why the lead compound is modified to arrive at a claimed compound required for a prima facie case of obviousness.

After KSR a prima facie case of obviousness for a chemical compound still, in general, begins with the reasoned identification of a lead compound and comparison of that lead compound to the claimed compound.³

i) Giraud discloses a huge genus of siloxane compounds.

Giraud at column 3, line 55 to column 5, line 19 discloses a vast number of possible siloxane resin molecules (Giraud constituent (b)) having many different possible structures. Giraud at column 5, line 20 to column 7, line 32 discloses a vast number of possible silane crosslinking agent molecules (Giraud constituent (c)) having many different possible structures.

² Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

³ MPEP section 2144.08(II)(A)(1 and 2). See also Eisai Co. v. Dr. Reddy's Labs., Ltd., 533 F.3d 1353 (Fed. Cir. 2008) and Takeda Chemical Industries, Ltd. v. Alphapharm Pty, Ltd., 492 F.3d 1350 (Fed. Cir. 2007).

ii) The rejection does not identify a “lead compound” or show how to modify that lead compound to arrive at Applicants’ claimed structure.

The rejection does not identify where either Applicants’ functional siloxane of claim 1 or crosslinker of claim 6 is found in Giraud. The rejection does not indicate which of Giraud’s components a to h allegedly anticipate which of Applicant’s recited components. The Office rejection does not identify a “lead compound”; does not identify any reason to choose that lead compound from the vast number of possibilities in Giraud; does not identify differences between that lead compound and Applicants’ claimed structures and does not identify any reason to modify the “lead compound” to arrive at Applicants’ claimed structure. The rejection merely reiterates that components a to h are present and that the “reference discloses all the limitations of the claims”. The rejection does not establish a prima facie case of obviousness. Claims 1, 6, 9, 12, 38, 40 and 41-43 are patentable for at least this reason.

2) Applicants’ response to the rejection of claims 1, 6, 9, 12, 38, 40 and 41-43 under 35 U.S.C. §103(a).

Claims 1, 6, 9, 12, 38, 40 and 41-43 were alternatively rejected under 35 U.S.C. §103(a) as allegedly being obvious over International Publication No. WO 01/40417 to Giraud et al, for the reasons given in point 4 of the action. Applicants traverse this rejection. Claims 1, 6, 9, 12, 38, 40 and 41-43 are patentable for at least the reasons discussed in paragraph 1 above.

3) Applicants’ response to the rejection of claim 21 under 35 U.S.C. §103(a).

Claim 21 was rejected under 35 U.S.C. §103(a) as allegedly being obvious in view of International Publication No. WO 01/40417 to Giraud et al, for the reasons given in point 5 of the action. Applicants traverse this rejection.

- a) **The rejection is improper as Giraud does not teach or suggest all of the features of Applicants' claimed composition.**

As discussed above Giraud does not disclose a base or a pH of 7 - 11 as recited in parent claim 1. Claim 21 is patentable for at least this reason.

4) Applicants' response to the rejection of claim 23 under 35 U.S.C. §103(a).

Claim 23 was rejected under 35 U.S.C. §103(a) as allegedly being obvious in view of International Publication No. WO 01/40417 to Giraud et al, for the reasons given in point 6 of the action. Applicants traverse this rejection.

- a) **The rejection is improper as Giraud does not teach or suggest all of the features of Applicants' claimed composition.**

- i) **Giraud does not disclose a "base" or a "pH".**

As discussed above Giraud does not disclose a base or a pH of 7 - 11 as recited in parent claim 1. Claim 23 is patentable for at least this reason.

- ii) **Giraud does not disclose a "molecular weight" or recited functional siloxane structure.**

Claim 23 reads in pertinent part: "said functional siloxane having the following structure: $\text{HO}(\text{CH}_3)_2\text{-Si}(\text{O-Si}(\text{CH}_3)_2\text{-O-Si}(\text{CH}_3)_2)_x\text{-O-Si}(\text{CH}_3)_2\text{OH}$, where x is selected such that said functional siloxane has a **molecular weight** in the range of 4,000 - 100,000." Applicants point out that claim 23 recites "molecular weight" and not "viscosity".

The rejection admits that the features of claim 23 are not disclosed within Giraud. The Office goes on to assert that "polysiloxanes having *viscosities* falling in the claimed range" can be found in U.S. Patent Nos. 2,891,920 and 3,294,725 referred to in Giraud as support for this rejection. The 2,891,920 patent of Hyde does not appear to disclose any molecular weight therein. The 3,294,725 patent of Hyde discloses molecular weights for the TABLE of EXAMPLE 22 (spanning the top of columns 13 and 14).

However, as shown in column 2 of that TABLE the molecular weights are for a silcarbane having a different molecular structure than recited in claim 23. All of the features of claim 23 are not shown in Giraud, singly or combined with the '920 and '725 patents. Claim 23 is patentable for at least this reason.

5) Applicants' response to the rejection of claim 39 under 35 U.S.C. §103(a).

Claim 39 was rejected under 35 U.S.C. §103(a) as allegedly being obvious in view of International Publication No. WO 01/40417 to Giraud et al, for the reasons given in point 7 of the action. Applicants traverse this rejection.

Claim 39 recites:

A mold release composition according to claim 1, comprising the following composition:

- 0.04-2.99 weight percent silanol-functional siloxane;
- 0.018-4.98 weight percent alkoxy-functional crosslinker;
- 0.009-2 weight percent catalyst;
- 0.04-4.8 weight percent thickening agent activatable at a pH of 7 to 11; and
- 0.1-2 weight percent base.

i) Giraud does not disclose any "base" or a "pH".

Claim 39 recites the presence of 0.1-2 weight percent base. As discussed above Giraud does not disclose any base, let alone the recited 0.1-2 weight percent of base, or a pH of 7 - 11 as recited in parent claim 1. Claim 39 is patentable for at least this reason.

ii) The assertion that all of the recited features of claim 39 are "result-effective variables" is incorrect and unsupported.

The rejection asserts that the amounts of each of Applicants' recited siloxane, crosslinker, catalyst, thickening agent and base are nothing more than "result effective variables".

As stated in In re Antonie, 559 F.2d 618; 195 U.S.P.Q. 6 (CCPA 1977):

The PTO . . . appear to argue that it would always be obvious for one of ordinary skill in the art to try varying every parameter of a system in order to optimize the effectiveness of the system even if there is no evidence in the record that the prior art recognized that particular parameter affected the result. As we have said many times, obvious to try is not the standard of 35 USC 103.

If a parameter is not recognized in the prior art as one that would affect results it is not obvious to vary that parameter.⁴

There is no teaching or disclosure in Giraud concerning a pH of 7-11, use of a base or use of a thickening agent activatable at a pH of 7 to 11. There is no evidence of record that a pH of 7-11, use of a base or use of a thickening agent activatable at a pH of 7 to 11 is recognized in the record as a result effective variable.

As stated in In re Lee, 61 USPQ2d, 1430 (Fed. Cir. 2002):

The determination of patentability on the ground of unobviousness is ultimately one of judgment. In furtherance of the judgmental process, the patent examination procedure serves both to find, and to place on the official record, that which has been considered with respect to patentability. [When] the examiner and the Board . . . rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

If the Examiner maintains the position that the amounts and components of claim 39 are result effective variables, the Examiner is respectfully requested to indicate where such variables are recognized by the record. If this assertion is not found in record and is instead based on the knowledge of the Examiner, then the Examiner is requested to supply an affidavit conforming to 37 C.F.R. §1.104(d)(2).

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⁴ Ex parte Whalen II, 14, appeal 2007-4423 (BPAI 2008)

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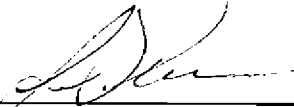
In summary, Applicants have addressed each of the objections and rejections in the present Office Action. It is believed the application now stands in condition for allowance, and prompt favorable action thereon is respectfully solicited.

The Examiner is invited to contact Applicants' attorney if a conversation will hasten prosecution of this application. All postal correspondence should be directed to the address given below.

Respectfully submitted,

Zheng Lu et al

Date: 12-4-2008

By: 
James E. Piotrowski
Registration No. 43,860
Attorney for Applicants

HENKEL CORPORATION
Legal Department
1001 Trout Brook Crossing
Rocky Hill, CT 06067
860.571.2501 (Office)
860.571.5028 (Fax)

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